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PATENT

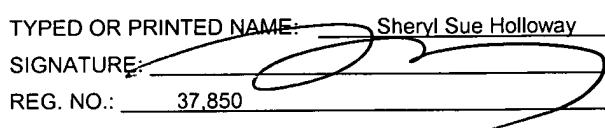
Application No.: 09/659,864
Filing Date: September 12, 2000
First Named Inventor: J. Leslie Vogel, III
Examiner's Name: Tongoc Tran
Art Unit: 2134
Attorney Docket No.: 004860.P2436

- ☐ An Amendment After Final Action (37 CFR 1.116) is attached and applicant(s) request expedited action.
- ☒ Charge any fee not covered by any check submitted to Deposit Account No. 02-2666.
- ☒ Applicant(s) hereby request and authorize the U.S. Patent and Trademark Office to (1) treat any concurrent or future reply that requires a petition for extension of time as incorporating a petition for extension of time for the appropriate length of time and (2) charge all required fees, including extension of time fees and fees under 37 CFR 1.16 and 1.17, for any concurrent or future reply to Deposit Account No. 02-2666.
- ☐ Applicant(s) claim small entity status (37 CFR 1.27).

ATTACHMENTS

- ☐ Preliminary Amendment
- ☐ Amendment/Response with respect to Office Action
- ☐ Amendment/Response After Final Action (37 CFR 1.116) (reminder: consider filing a Notice of Appeal)
- ☐ Notice of Appeal
- ☐ RCE (Request for Continued Examination)
- ☐ Supplemental Declaration
- ☐ Terminal Disclaimer (reminder: if executed by an attorney, the attorney must be properly of record)
- ☐ Information Disclosure Statement (IDS)
- ☐ Copies of IDS citations
- ☐ Petition for Extension of Time
- ☐ Fee Transmittal Document (that includes a fee calculation based on the type and number of claims)
- ☐ Cross-Reference to Related Application(s)
- ☐ Certified Copy of Priority Document
- ☒ Other: Request For Rehearing Under 37 C.F.R. §41.52
- ☐ Other:
- ☐ Check(s)
- ☒ Postcard (Return Receipt)

SUBMITTED BY:

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Atty Docket No. 4860.P2436

Patent

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)	Examiner:	Tran, Tongoc
)		
Vogel, J. Leslie III)	Art Unit:	2134
)		
Application No. 09/659,864)	Confirmation No.:	5866
)		
Filed: September 12, 2000)		
)		
For: USER CONTROL OF A)		
SECURE WIRELESS)		
COMPUTING NETWORK)		
)		

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REQUEST FOR REHEARING UNDER 37 C.F.R. §41.52

Appellant respectfully requests rehearing of the Appeal for the above-referenced application because the Decision of the Board on October 19, 2007 did not address two of the issues raised in Appellant's Appeal Brief. Appellant further respectfully requests a rehearing to reconsider the Board's sustaining of the rejection of the claims under 35 U.S.C. § 103.

I. ISSUES FOR REHEARING

1. Whether the Board should render a decision on all issues on Appeal.
2. Whether the Examiner correctly interpreted the prior art in rejecting Applicant's claims as obvious.

II. ARGUMENTS

1. The Board should issue a ruling on Appeal issues I and II to have a complete record of the application on appeal.

In the Appeal Brief filed July 17, 2006, Appellant raised four issues:

- I. Whether claims 1, 16, 21, 26, 31, 36, 42 and 46 were properly rejected under 35 U.S.C. § 112, first paragraph for lack of written description;
- II. Whether claims 1, 16, 21, 26, 31, 36, 42 and 46 were anticipated by Patiyoote, et al. ("Technique for authentication protocols and key distribution on wireless ATM networks", ACM SIGOPS Operating System Review, Volume 32, Issue 4, October 1998);
- III. Whether claims 1-3, 9-17, 19-22, 24-27, 29-32, 34-38, 40-48 and 50-51 were rendered obvious by the combination of Lewis (U. S. Patent 6,526,506) and Quick (U.S. Patent 6,178,506); and
- IV. Whether claims 4-8, 18, 23, 28, 33, 39, and 49 were rendered obvious by the combination of Lewis, Quick and Schneier ("Applied Cryptography, Second Edition, Protocols, Algorithms, and Source Code in C", John Wiley & Sons, Inc., 1996).

Appellant respectfully submits that the record for a patent application is incomplete if the Board does not rule on all the issues before it on appeal. Furthermore, as the Board is aware, one of Appellant's options after receiving an unfavorable decision on appeal is to file a continuation with new claims that address the findings of the Board. Because the Board did not specifically rule on whether Appellant's claims are supported by the specification, and did not specifically rule on whether Appellant's claims are anticipated by Patiyoote, Appellant cannot determine whether the Board sustained all the Examiner's rejections, or only the 35 U.S.C. § 103 rejections specifically set forth in the Decision. Therefore, Appellant is unable to determine the appropriate scope of the claims to be filed with the continuation.

Accordingly, the record for the present application is incomplete with regard to the issues of written description and novelty, and thus the should rehear the Appeal to decide these two issues.

2. The Examiner's interpretation of Lewis is contrary to the clear teaching of the reference.

Lewis discloses a wireless access point that may conform to the IEEE 802.11 standard, which specifies that a wireless network that can use either "open system" or "shared key" authentication protocols. Based on this fact, the Board sustained the Examiner's interpretation that Lewis teaches Appellant's claimed characteristic of sending a security preference by an access point to a station, where the security preference specifies one authentication protocol from a set of authentication protocols supported by the access point. In addition, the Board used the same reasoning to sustain the Examiner's interpretation that Lewis teaches Appellant's claimed characteristic of sending a request for a security preference from the station to the access point.

However, Lewis does not explicitly disclose that the access point sends a security preference to a station, and Lewis does not explicitly disclose that a station sends a request for a security preference to the access point. Thus, the Board found the Examiner correctly interpreted Lewis as inherently disclosing those claimed characteristics of Applicant's access point and station. Appellant respectfully submits that such an interpretation of Lewis is contrary to the express teachings of the reference.

Lewis discloses that a system administrator pre-determines which stations will communicate using encryption and which will communicate without encryption ("clear"), and that the access point stores a table specifying the "clear" stations:

As will be described in more detail below in connection with FIG. 4, the key distribution server 76 maintains in the system device table 152 a list of devices. Such list represents a complete list of devices (e.g., mobile terminals) which are authorized to communicate with the network 51 in either an encrypted or a non-encrypted format. The contents of the system device table 152 are input by a system administrator via an input device 154 (e.g., keypad) coupled to the processor 142, for example. The system administrator represents a person authorized to determine which particular mobile terminals are entitled to gain access within the system 20. [Lewis: col. 9, lines 54-65]

Referring briefly to FIG. 5, an exemplary clear table 126 maintained in each of the access points 54 is shown. The clear table 126 includes a list of the network addresses or network identifications of those devices identified in the system device table 152 as being granted non-encrypted access to the system 20. [col. 10, lines 36-41]

The mere fact that a certain thing may result from a given set of circumstances is not sufficient to support a holding of inherency. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). Instead, the principal of inherency requires that the allegedly inherent characteristic necessarily and always flows from the teachings of the prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Any single example in the prior art reference that does not exhibit the allegedly inherent characteristic destroys inherency. Because Lewis teaches that the authentication protocol for a station is pre-determined, Lewis' access point does not need to send a security preference to the station to specify an authentication protocol. Moreover, because Lewis' access point stores the clear table, the access point knows which stations use encryption and which do not. Thus, Lewis' station does not need to send a request for a security preference to the access point because the authentication protocol for the station is pre-determined. Therefore, Applicant's claimed characteristics, which were asserted as inherently present in Lewis, are not necessary for the operation of Lewis' access point and station as disclosed, and thus these characteristics cannot be considered as necessarily flowing from Lewis' teachings.

Accordingly, Examiner's interpretation of Lewis as inherently disclosing claimed characteristics of Appellant's access point and/or station is contrary to the express teachings of Lewis, and the Examiner's rejection of the claims as obvious over the combination of Lewis and Quick, and the combination of Lewis, Quick and Schneier cannot be sustained.

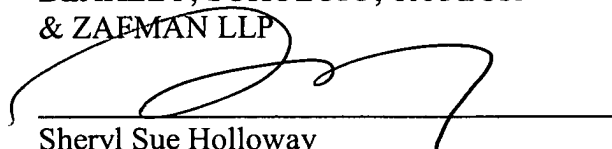
III. CONCLUSION

Appellant respectfully requests the Board reissue the October 19th Decision to rule on the written description and novelty issues raised by Appellant. Appellant further respectfully requests the Board reissue the October 19th Decision to reverse the Examiner's rejections of the claims under 35 U.S.C. § 103.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR
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Dated: December 19, 2007



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